

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Rajesh (nmi) Bhalla et al.
Serial No.: 10/072,055
Filing Date: February 5, 2002
Group Art Unit: 2616
Confirmation No. 1173
Examiner: Daniel J. Ryman
Title: OPTIMIZATION OF POINT-TO-POINT SESSIONS

Mail Stop - AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

REMARKS

Applicants contend that the rejections of Claims 1-41 contain clear legal and factual deficiencies, as described below. Applicants request a finding that these rejections are improper and that the claims are allowable.

Section 103 Rejections

The Examiner rejects Claims 1-41 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,985,464 to Harper et al. ("*Harper*") in view of U.S. Patent No. 6,628,671 to Dynarski et al. ("*Dynarski*"), and in further view of U.S. Patent Application Pub. No. 2003/0053431 to Madour ("*Madour*"). Applicants respectfully traverse these rejections.

Applicants respectfully submit that the combination of *Harper*, *Dynarski*, and *Madour* proposed by the Examiner fails to disclose, teach, or suggest elements specifically recited in Applicants' claims. For example, the *Harper-Dynarski-Madour* combination proposed by the Examiner fails to disclose, teach, or suggest the following recited in independent Claim 1:

determining, at the packet data serving node, whether the mobile node communicated with a previous packet controller function serviced by the packet data serving node.

In the Final Office Action mailed November 7, 2007 ("Final Office Action"), the Examiner relies on the passage at Col. 3, Lines 60-63 of *Dynarski* to teach these elements. (Final Office Action, Page 5.) According to the Examiner, this passage discloses "determin[ing] if the mobile node communicated with one of its ports previously." (Final Office Action, Pages 5-6.) In the Advisory Action mailed January 22, 2008 ("Advisory Action"), however, the Examiner concedes that ***a port is not a packet controller function (PCF)***. (Advisory Action, Continuation Sheet (stating "Applicant asserts ... Harper discloses that a port is different from a PCF. ***Examiner agrees.***") (emphasis added).) Therefore, since a port is not a packet controller function, *Dynarski* fails to disclose "determining, at the packet data serving node, whether the mobile node communicated with a ***previous packet controller function*** serviced by the packet data serving node" of Claim 1 (emphasis added).

The Examiner further contends that these elements are taught by the combination of *Harper* and *Dynarski*. (Final Office Action, Page 5.) In particular, the Examiner contends:

Dynarski teaches, in a different system, a technique for determining whether to negotiate a new PPP session so as to use an existing set of PPP parameters where possible. As such, Examiner's combination of Harper and Dynarski does not directly import Dynarski's system into Harper's system. Rather, Examiner's combination of Harper and Dynarski imports the technique of Dynarski and applies it in Harper's system. In this scenario, Examiner analogizes Dynarski's ports to Harper's PCF and Dynarski's network access server to Harper's PDSN.

(Advisory Action, Continuation Sheet.) That is, the Examiner assumes that ports are analogous to PCFs and network access servers are analogous to PDSNs, and argues that—given these assumptions—*Dynarski's* technique can be imported into *Harper's* system to teach the above elements of Claim 1.

The combination of *Dynarski's* technique imported into *Harper's* system, however, still fails to disclose, teach, or suggest the above elements of Claim 1. First, it is not obvious to import *Dynarski's* technique into *Harper's* system. To combine *Dynarski* and *Harper*, the Examiner assumes that *Dynarski's* network access server is analogous to *Harper's* PDSN and that *Dynarski's* ports are analogous to *Harper's* PCF. *Dynarski's* ports are ports of *Dynarski's* network access server. (See *Dynarski*, Col. 3, Line 60 - Col. 4, Line 3.) If a network access server can be taken as a PDSN (to which Applicants do not admit), then it is not obvious that a port of the network access server is analogous to a PCF *that is distinct from* the PDSN. Since the assumption is not obvious, then the combination that relies on the assumption is also not obvious.

Second, there is no reasonable expectation of success that *Dynarski's* technique can be imported into *Harper's* system. The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. MPEP §2143.02 (citing *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)). According to the Examiner, *Dynarski's* technique involves “determin[ing] if the mobile node communicated with one of its ports previously.” (Final Office Action, Pages 5-6.) In *Harper's* system a port of a PDSN can connect to multiple PCFs. (See *Harper*, Fig. 4 (illustrating that PDF and PDF can both connect to port D of PSTN); see also *Harper*, Col. 7, Line 45 - Col. 8, Line 5.) Thus, the port used *Dynarski's* technique cannot serve to identify a particular previous PCF in *Harper's* system. Accordingly, there is no reasonable expectation of success that *Dynarski's* technique can be imported into *Harper's* system.

Third, in combining *Dynarski's* technique and *Harper's* system, the Examiner fails to consider *Dynarski* as a whole. A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. MPEP § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). As discussed above, *Dynarski's* technique uses ports, not PCFs, to determine whether to negotiate a new PPP session. (*See also Dynarski*, Col. 3, Line 60 - Col. 4, Line 3.) Taken as a whole, *Dynarski* fails to disclose, teach, or suggest the above elements of Claim 1.

Consequently, at a minimum, the *Harper-Dynarski-Madour* combination proposed by the Examiner fails to disclose, teach, or suggest the elements of Claim 1. For at least this reason, Applicants contend that the rejection of Claim 1 is improper, as are the rejections of its dependent claims. For the same or analogous reasons, the rejections of Claims 8, 9, 15, 16, 23, 26, 32, 33, 39, 40, and 41 are improper, as are the rejections of their dependent claims. Accordingly, Applicants request a finding that these rejections are improper and that Claims 1-41 are allowable.

CONCLUSION

As the rejections of Claims 1-41 contain clear deficiencies, Applicants respectfully request a finding that Claims 1-41 are allowable. To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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Date: February 7, 2008

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